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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KIRKPATRICK & LOCKHART LLP  
535 SMITHFIELD STREET  
PITTSBURGH, PA 15222

EXAMINER
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ESTRADA, ANGEL R

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/726,356

Applicant(s)

PERRELLA ET AL.

Examiner

Angel R. Estrada

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12/22/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 11 and 22 are objected to because of the following informalities:

In claim 1 line 1, change "USB" for --Universal Serial Bus (USB)--.

In claim 11 line 1, change "USB" for --Universal Serial Bus (USB)--.

In claim 22 line 5, change "USB" for --Universal Serial Bus (USB)--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnett et al (US 5,735,708, hereinafter Arnett).

Regarding claim 1, Arnett discloses a wall plate (10), comprising: a first surface; a second surface opposite the first surface; and four side edges connected to the first and second surfaces (see figure 1), wherein the wall plate (10) defines: a first opening (15) extending from the first surface to the second surface (see figure 1), wherein the first opening (15) is adapted to receive a USB connector (column 3 lines 30-33); and a second opening (see figure 1) extending from the first surface to the second surface

(see figure 1), wherein the second opening is adapted to receive an indicating light (see figure 1 or column 3 lines 30-33)

Note: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. Therefore these limitations ("*adapted to receive a USB connector*" and "*adapted to receive an indicating light*") have not been giving any patentable weight

Regarding claim 2, Arnett discloses the wall plate (10), wherein the wall plate (10) is fabricated from an insulating material (column 3 lines 34-37).

Regarding claim 3, Arnett discloses the wall plate (10), wherein the first surface includes a planar portion (see figure 1).

Regarding claim 4, Arnett discloses the wall plate (10), wherein the first surface includes a tapered portion (see figure 1).

Regarding claim 5, Arnett discloses the wall plate (10), wherein the first opening (15) is a rectangular-shaped opening (see figure 1).

3. Claims 11, 12, 18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (US 6,466,434).

Regarding claim 11, Tsai discloses a USB wall plate (see figure 2a), comprising: a first surface; a second surface opposite the first surface; four side edges connected to the first and second surfaces (see figure 2a); and a printed circuit board (see figure 2a)

having a USB hub circuit (see figure 2a) connected thereto wherein the printed circuit board is connected to the second surface (see figure 2a)

Regarding claim 12, Tsai discloses the wall plate (see figure 2), wherein the USB hub circuit (see figure 2a) includes a plurality of USB connectors (21).

Regarding claim 18, Tsai discloses a wall plate (480 or see figure 4), wherein the USB hub circuit includes: a downstream USB connector (column 4 lines 5-13) that extends through a first opening defined by the wall plate (see figure 4); and an indicating light (42) associated with the downstream USB connector, wherein the indicating light extends through a second opening defined by the wall plate (see figure 4).

Regarding claim 20, Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit (see figure 3) includes a power supply (36).

Regarding claim 21, Tsai discloses the wall plate (480 or see figure 4), wherein the power supply (36) includes a transformer (column 3 line 65-column 4 line 4).

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Regarding claim 22, Tsai discloses the wall plate (480 or see figure 4), comprising: a first surface; a second surface opposite the first surface; four side edges connected to the first and second surface (see figure 4); and means for transmitting and receiving a USB signal (see figure 3), wherein the means for transmitting and receiving the USB signal is connected to the second surface (see figures 3 and 4).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnett et al (US 5,735,708, hereinafter Arnett) in view Pritchard et al (US 6,222,124, hereinafter Pritchard)

Regarding claim 6, Arnett discloses the claimed invention except for the wall plate defining a plurality of first openings extending from the first surface to the second surface. Pritchard teaches a wall plate (104 or see figure 3) having a plurality of first and second openings (see figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Arnett's wall plate with a plurality of

first openings as taught by Pritchard to provide the wall plate with more openings to attached more data or electrical connectors.

Regarding claim 7, the modified Arnett discloses the claimed invention except for the wall plate defining four first openings extending from the first surface to the second surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made the wall plate with more openings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

Regarding claim 8, Arnett discloses the claimed invention except for the second opening being a circular-shaped opening. It would have been an obvious matter of design choice to change the shape of the second opening from rectangular to circular, since such a modification would have involved a mere change in the shape of a component. Where the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular shape, a change of shape is generally recognized as being within the level of ordinary skill in the art. *Span-Deck Inc. V. FabCon, Inc.*, 215 USPQ 835.

Regarding claim 9, Arnett discloses the claimed invention except for the wall plate defining a plurality of second openings extending from the first surface to the second surface. Pritchard teaches a wall plate (104 or see figure 3) having a plurality of first and second openings (see figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Arnett's wall plate with a

plurality of second openings as taught by Pritchard to provide the wall plate with more openings to attached more data or electrical connectors.

Regarding claim 10, the modified Arnett discloses the claimed invention except for the wall plate defining four-second openings extending from the first surface to the second surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall plate with more openings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

5. Claims 13-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (US 6,466,434).

Regarding claim 13, Tsai disclose the wall plate (see figure 2a), wherein the USB hub circuit includes an upstream and a downstream USB connector (column 1 lines 29-39); but lacks having four downstream connectors. — It would have been obvious to one having ordinary skill in the art at the time the invention was made to add more four or more downstream connectors, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

Regarding claim 14, the modified Tsai discloses the wall plate (see figure 2a), wherein each of the four downstream USB connectors extend through openings defined by the wall plate (see figure 2a).



Regarding claim 15, Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit includes an indicating light (42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall plate with a plurality of indicating lights, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

Regarding claim 16, the modified Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit includes four indicating lights (see figure 4).

Regarding claim 17, the modified Tsai discloses the wall plate (480 or see figure 4), wherein each of the four indicating lights (see figure 4) extend through openings defined by the wall plate (see figure 4).

Regarding claim 19, Tsai discloses the claimed invention except for the USB hub circuit including a plurality of downstream USB connectors and a plurality of associated indicating lights. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall plate with a plurality of downstream USB connectors and a plurality of indicating lights, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Finke et al (US 6,421,941), Hunt (US 6,593,530), Shotey et al

(US 6,723,922), Wakino (US 6,491,541), Nguyen (US 5,485,356), Gaines et al (US 3,432,611) discloses a wall plate assembly. Huang (US 6,722,917), Chang (US 6,563,714) and Kikinis (US 5,841,424) disclose a USB hub assembly.

7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 Ext: 31. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Angel R. Estrada

May 24, 2004

  
DEAN A. REICHARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800